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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Masaya Tamaru

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MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC
8321 OLD COURTHOUSE ROAD
SUITE 200
VIENNA, VA 22182-3817

EXAMINER

WORKU, NEGUSSIE

ART UNIT

PAPER NUMBER

2625

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/820,032	Applicant(s) TAMARU, MASAYA	
	Examiner NEGUSSIE WORKU	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-17 is/are rejected.
- 7) ☒ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/08/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, filed 04/10/09, with respect to claims 1-2 and 10-15 have been fully considered and are persuasive. Upon further review, the examiner has incorporated the cited prior arts, to further teach the claimed limitation as set forth below.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-8, 10-20 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent¹ and recent Federal Circuit decisions² indicate that a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

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statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process.

In this case, specifically, claims 5-8 are directed to a system. However, use of the word "system" in the preamble does not inherently mean that the claims are directed towards a machine. These claims recite "a system" comprising solely of software alone and/or merely the manipulation of abstract ideas i.e. mathematical algorithms. Because of this, claims lack the necessary structural elements to be an "apparatus" and support even in its broadest reasonable sense, the preamble. Furthermore, applicants cite no such specific claim limitation to produce a useful, concrete, and tangible result as required by MPEP and case laws.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-8, 10-17 are rejected under 35 U.S.C. § 112, first paragraph because current case law (and accordingly, the MPEP) require such a rejection if a § 101 rejection is given because when Applicant has not in fact disclosed the practical application for the invention, as a matter of law there is no way Applicant could have disclosed how to practice the undisclosed practical application. This is how the MPEP puts it: ("The how to use prong of section 112 incorporates as a matter of law the

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requirement of 35 U.S.C. § 101 that the specification disclose as a matter of fact a practical utility for the invention.... If the application fails as a matter of fact to satisfy 35 U.S.C. §101, then the application also fails as a matter of law to enable one of ordinary skill in the art to use the invention under 35 U.S.C. § 112."); In re Kirk, 376 F.2d 936, 942, 153 USPQ 48, 53 (CCPA 1967) ("Necessarily, compliance with § 112 requires a description of how to use presently useful inventions, otherwise an applicant would anomalously be required to teach how to use a useless invention.") See, MPEP 2107.01 (IV), quoting In re Kirk (emphasis added). Examiner made a § 101 utility rejection of the claim because it fails to indicate a specific practical utility (i.e. practical application) for the claimed invention. Therefore, claims 1-8 and 10-17 are rejected on this basis.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-8, 9-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sones (USP 5, 911,003), and Shiraiwa (USP 7,098,944), further in view of Garcynski et al. (USP 6,357,658).

With regard to claim 1, Sones '003 teaches an apparatus (fig 2) for reproducing image data formed by imaging an object, (image formed by camera 30 of fig 2) comprising: a reader circuit (30 of fig 2) for reading out image data, first color space information represented by a plurality of coefficients converting the image data in a color

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space set when imaging the object, (col.3, lines 57-65) and color temperature information optimum for the first color space information (fig 6c, 372-378 of fig 6c); a first color space corrector for correcting the image data based on the first color space information (co1.1, lines 35-40); a second color space corrector for correcting the image data adjusted by said color temperature adjuster based on second color space information represented by a plurality of coefficients converting the image data to a color space set in said apparatus, (the offset values for each color are about 5-10 for the selected 0-255 base ten range of each color component. The offset values may drift with temperature and time so that it is preferred to perform an offset correction on every image using a portion of representative pixels from region B, col.7, lines 20-30).

Sones '003' does not teach a color temperature adjuster for correcting the image data corrected by said first color space corrector based on the color temperature information.

However, Shiraiwa '944' teaches a color temperature adjuster for correcting the image data corrected by said first color space corrector based on the color temperature information (col.2, line 5-15).

Further, Sones '003' in combination with Shiraiwa '944', still do not teach or disclose wherein the reader circuit reads out the image data in a form of raw pixel data.

Garczynski '658' teaches the reader circuit reads out the image data in a form of raw pixel data (as discussed in co1.12, lines 10-19, data is normally transmitted in the orientation scanned, but may be rotated in memory to present a view consistent with

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normal viewing (e.g., portrait or landscape), the entire form may be imaged at 200 dpi, but to conserve, memory, as well as processing and transmission times, signature areas are normally restricted to smaller rectangular areas. Signatures are most frequently scanned at 200 dpi, and data is transferred as a black/white image in either raw pixel form or compresses via facsimile group 4 Algorithm).

Therefore, It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified the imaging device of Sones '003' in combination with Shiraiwa '944' by the teaching of Garcynski '658' for the purpose of obtaining a perfect final image, for all the prints of different color to be exactly superimpose, and it should be clear to one skilled in the art that anyone of a wide variety of image processing device can be similarly employed to accomplish this desired result without depending from the teaching of the present invention.

With respect to claim 2, Sones teaches the apparatus (as shown in fig 2 and 3), wherein the first color space information includes a standard prescription for a color space proposed by a manufacturer, and the second color space information defines a color space desired by a user of said apparatus (co1.12, lines 5-15).

With respect to claims 3 through 8 and 10-17, since claims are similar to above rejected claims. Claims are similarly rejected as applied to above indicated claim 1 and 2.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Negussie Worku whose telephone number is (571)272-7472. The examiner can normally be reached on 9am-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Negussie Worku/
Examiner, Art Unit 2625